

DEC 08 2008



Ralph E. Jocke
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TRANSMITTING: 7 PAGES (INCLUDING THIS PAGE)

NAME: Director of Technology Center 3600
Commissioner for Patents
U.S. Patent and Trademark Office

FAX NUMBER: (571) 273-8300

DATE: December 6, 2008

SENDER: Ralph E. Jocke, Esq.

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In Re Application of:	Donald McCoy, et al.	Art Unit 3694
Serial No.:	10/620,911	Examiner Hai Tran
Confirm. No.:	8962	Docket: D-1171 R
Filed:	July 15, 2003	
For:	AUTOMATED BANKING MACHINE BOOTABLE MEDIA AUTHENTICATION	

Sir:

Please find enclosed a "Petition for withdrawal of premature final rejection" for filing in the above identified Application. No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Petition and any other fee due to Deposit Account 09-0428.

Respectfully,

A handwritten signature in black ink, appearing to read "Ralph E. Jocke".

Ralph E. Jocke Reg. No. 31,029

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this document and the documents indicated as enclosed herewith are being sent by facsimile transmission to the U.S. Patent and Trademark Office this 6 day of December 2008.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Donald McCoy, et al.)
Serial No.: 10/620,911) Art Unit 3694
Confirmation: 8962)
Filed: July 15, 2003) Patent Examiner
Title: AUTOMATED BANKING) Hai Tran
MACHINE BOOTABLE)
MEDIA AUTHENTICATION)

Director of Technology Center 3600
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Kindly enter the following petition without prejudice, which is being submitted within two months of the Office Action dated October 8, 2008. If further request for reconsideration by the Examiner is first required, then this petition should be considered as such.

PETITION FOR WITHDRAWAL OF PREMATURE FINAL REJECTION

Comments

Applicants petition that the final rejection dated October 8, 2008 should be withdrawn because it is premature and legally improper. Because of the premature final rejection, Applicants have not been given fair opportunity in accordance with 37 C.F.R. 1.111 to properly rebut the Office's newly imposed ground of rejection. Applicants also respectfully submit that the Office is committing prejudicial error by depriving Applicants of their administrative due process rights (e.g., timely notice of the Examiner's position and opportunity for unhindered response thereto).

The record shows that the conditions did not meet the legal criteria for the Office to apply a final rejection on October 8, 2008. The Office Action dated October 8, 2008 acknowledged that an immediately prior Office Action was prematurely made Final. However, instead of issuing a corresponding non-final rejection in a Non-Final Action, the Office made the subsequent Office Action dated October 8, 2008 a Final Action as well. Thus, the Final Office Action dated October 8, 2008 is *prima facie* premature.

Background

The following dates and papers are associated with this application:

1. 01/17/2008 1st rejection
2. 04/18/2008 Response without amendment to claims 1-13, 19, and 22-34
3. 07/31/2008 1st final rejection (with new rejections to claims 1-13, 19, and 22-34)
4. 09/29/2008 Response to Request withdrawal of premature 1st final rejection

5. 10/08/2008 2nd final rejection - (which withdrew the 1st final rejection) but did not make the rejection non-final

The Applicable Legal Standards

MPEP § 706.07(a) states:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

MPEP § 706.07(f) (III) (M) states:

"If prosecution is to be reopened after a final Office action has been replied to, the finality of the previous Office action should be withdrawn . . . For example, if a new reference comes to the attention of the examiner which renders unpatentable a claim . . . the Office action should begin with a statement to the effect: 'The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below.' Form paragraph 7.42 could be used in addition to this statement. See MPEP 706.07(d)."

The Facts of Record

The Office Action dated January 17, 2008 contained a 35 U.S.C. §103(a) rejection of claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over Yoon, U.S. Patent No. 6,088,794, in view of James, U.S. Patent No. 6,240,519. This rejection was withdrawn in the first Final Office Action dated July 31, 2008 and a new rejection was applied against claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over Harding, et al., U.S. Patent No. 6,651,188 ("Harding") in view of Watson, U.S. Patent No. 5,475,839.

However, Applicants' Response filed April 17, 2008 (to the Office Action dated January 17, 2008) did not contain *any* amendment to claims 1-13, 19, and 22-34. Nor did Applicants' April 17, 2008 Response include an IDS. Thus, the record itself shows the final rejection of July 31, 2008 to be *prima facie* premature.

Applicants filed a Response to the final Office Action dated July 31, 2008, which requested withdrawal of the premature final rejection. In reply, another Office Action dated October 8, 2008 was issued in which the Office agreed that the prior final rejection was in fact premature, and agreed to withdraw the Final Office Action dated July 31, 2008. However, rather than making the rejection non-final, in the Office Action dated October 8, 2008, the Office made the rejection final once again.

The record shows evidence that: (1) the Examiner introduced a new ground of rejection; (2) the new ground of rejection was not necessitated by amendment of the claims or an IDS; (3) The Office failed to apply the rejection as a non-final rejection. That is, the facts of record show that the conditions did not meet the legal criteria for the Office to make a final rejection on either July 31, 2008 or October 8, 2008. Therefore, the pending final rejection dated October 8, 2008 is *prima facie* premature and should be withdrawn.

Additional Comment

In the pending final Office Action (at page 2) the Examiner admits that the final rejection in the final Office Action (dated July 31, 2008) was premature. This admission of error provides clear evidence that the final Office Action dated July 31, 2008 was defective by not making the new grounds of rejection non-final.

On one hand the Examiner admits that there was Office error with regard to the finality of the Office Action dated July 31, 2008. On the other hand the Examiner wants Applicants to be the one who receives the negative consequences of the Office's error via making a second premature final rejection in the Office Action dated October 8, 2008. However, Applicants respectfully decline the invitation. Proper examining procedure, as set forth in the MPEP, would have been for the Examiner to issue a non-final rejection as soon as he became aware of the error. This did not occur, which resulted in yet another improper premature final rejection.

Applicants also respectfully submit that the Office is committing prejudicial error by depriving Applicants of their administrative due process rights (e.g., timely notice of the Examiner's position and opportunity for unhindered response thereto).

In order for the new 35 U.S.C. §103(a) rejections to be legally proper, they must first be applied in a non final rejection. This situation has not yet occurred.

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Conclusion

Appellants respectfully submit that the Office has failed to issued a Non-Final Office Action with the new grounds of rejection presented in the premature Final Office Actions dated July 31, 2008 and October 8, 2008. The final rejection of October 8, 2008 is *prima facie* premature. Applicants petition should be granted for the reasons presented herein. The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,


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